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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/849,735	05/04/2001	John A. Blackman	103291-42913	8085

26345 7590 07/30/2003

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EXAMINER

FRANCIS, FAYE

ART UNIT

PAPER NUMBER

3712

DATE MAILED: 07/30/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Applicati n N .	Applicant(s)	
	09/849,735	BLACKMAN ET AL.	
	Examin r	Art Unit	
	Faye Francis	3712	

-- The MAILING DATE of this communication appears on the cover sheet with the c rrespondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 12 May 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-8 and 20-30 is/are pending in the application.
- 4a) Of the above claim(s) 30 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-8 and 29 is/are allowed.
- 6) ☒ Claim(s) 20-24 and 26-28 is/are rejected.
- 7) ☒ Claim(s) 25 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 12 May 2003 is: a) ☒ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All   b) ☐ Some \*   c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                  | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

**DETAILED ACTION**

***Terminal Disclaimer***

1. The terminal disclaimer filed on 5/12/03 disclaiming the terminal portion of any patent granted on this application, which would extend beyond the expiration date of 3/9/2020 has been reviewed and is accepted. The terminal disclaimer has been recorded.

2. The allowability of claims 1-7 is hereby withdrawn. Also, The objection to claim 26 on the ground that being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims is hereby withdrawn. Additionally, the rejection of claim 29 under 112 second paragraph for indefiniteness on the ground that term "convex-shaped" being insufficiently defined is also hereby withdrawn.

***Specification***

3. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: proper antecedent basis should be provided in the specification for the requirement in claim 28 that "the tab is arranged to extend through the valve and enables a manual change of the switch position". Additionally, proper antecedent basis should be provided in the specification for the requirement in claims 20, 24 and 27 that "the switch is configured to automatically change from the open circuit position to the closed circuit position". Additionally, proper antecedent basis should be provided in the specification for the requirement in claim 30 that "a position

switching element capable of altering between said closed position and said open position of said switch upon a change in the external device's operating states".

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 28 and 30 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. It is not clear how the tab is arranged to extend through the valve and enables a manual change of the switch position as required in claim 28. Additionally, it is not clear how the position switching element is capable of altering between the closed position and the open position of the switch upon the change in the external device's operating states" as now recited in last two lines of claim 30.

6. Claim 30 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention, i.e., New Matter.

The specification as originally filed does not provide support for the teaching of "a position switching element capable of altering between said closed position and said

open position of said switch upon a change in the external device's operating states" as now recited in last two lines of claim 30.

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

8. Claims 20-21, 23-28 and 30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 20, 24 and 27 are indefinite because it is not clear how the word "automatically", is intended to further limit the device.

With respect to claim 23: it is not clear how the tab is configured to change the switch from the open circuit position to the closed circuit position?

With respect to claim 30: it is not clear how the position switching element is capable of altering between the closed position and the open position of the switch upon the change in the external device's operating states

***Claim Rejections - 35 USC § 102***

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 1, 8, 20-22 and 29-30 are rejected under 35 U.S.C. 102(b) as being anticipated by Chabert.

Chabert discloses in Figs 1-6, an inflatable object [balloon 1], a shell [envelope 2], a circuit coupled to the interior portion [Fig 5] and a switch 25, which is configured to automatically change from the open circuit position to the closed circuit position as the inflatable apparatus is inflated [col 1 lines 19-27].

The requirement in claims 1 and 21 for a tab is met by either end part 21 or actuation contact 26 wherein the proximal portion of the tab is in contact with the switch and the distal portion of the tab is coupled to the inflatable device as recited in claim 1 and the distal portion of the tab is coupled to interior surface as recited in claim 8.

***Claim Rejections - 35 USC § 103***

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 2 and 3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chabert in view of Official Notice hereby taken that it is well known to utilize batteries to power toys.

Chabert discloses most of the elements of these claims as stated above but for a plurality of batteries.

In view of the Official Notice taken above that it is well known to utilize batteries to power toys, it would have been obvious to provide the device of Chabert with batteries in order to generate additional power.

13. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Chabert in view of Margolis.

~~Chabert discloses most of the elements of these claims as stated above but for a~~  
Mylar balloon.

Margolis teaches the concept of making balloons out of Mylar material. It would have been obvious to make the balloon in the device of Chabert out of Mylar material as suggested in Margolis reference in order to increase durability.

14. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Chabert in view of Official Notice hereby taken that piezoelectric sound generators are conventional.

Chabert discloses most of the elements of these claims as stated above but for a piezoelectric sound generator.

In view of the Official Notice above that piezoelectric sound generators are conventional, it would have been obvious to provide the device of Chabert with the piezoelectric sound generator in order to obtain a durable, inexpensive, light weight and high volume sounding device making the device more fun to play with.

15. Claims 23-24 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chabert in view of Margolis and in view of Official Notice hereby taken that it is well known to utilize batteries to power toys and in view of Official Notice hereby taken that piezoelectric sound generators are conventional.

Chabert discloses most of the elements of these claims as applied to claims 1, 8 and 20-22 above including a valve 31 as recited in claim 26.

Chabert does not disclose a plurality of sheets, a sound producing circuit comprising a plurality of batteries, a piezoelectric sound generator and a Mylar balloon.

Margolis teaches the concept of providing Mylar balloon having a plurality of sheets and a sound producing circuit. It would have been obvious to make the balloon in the device of Chabert out of Mylar material having a plurality of sheets as suggested in Margolis reference in order to increase durability.

In view of the Official Notice taken above that it is well known to utilize batteries to power toys, it would have been obvious to further provide the modified device of Chabert with batteries in order to generate additional power.

In view of the Official Notice above that piezoelectric sound generators are conventional, it would have been obvious to further provide the modified device of Chabert with the piezoelectric sound generator in order to obtain a durable, inexpensive, light weight and high volume sounding device making the device more fun to play with.

***Allowable Subject Matter***

16. Claims 5-6 and 25 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

16. Claims 27-28 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, first or second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.



***Response to Arguments***

17. Applicant's arguments with respect to claims 1-8 and 20-29 have been considered but are moot in view of the new ground(s) of rejection.

In response to applicant's argument on page 14 second full paragraph, that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., page 3, lines 12-15 of the specification) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Also, note that the applicant refers to a lot of different things on page 3. For example only, claims 20, 24 and 27 never states a method of preventing premature discharge of a power source.

***Conclusion***

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Faye Francis whose telephone number is 703-306-5941. The examiner can normally be reached on M-F 6:30-3:00.

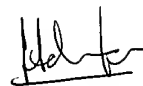
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris Banks can be reached on 703-308-1745. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9302 for regular communications and 703-872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.

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FF  
July 23, 2003

A handwritten signature in black ink, appearing to be "H. H. H.", written over a horizontal line.

2003/07/23